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OFFICE OF PETITIONS

In re Application of Kapitskaia, et al.	:	
Application No. 09/841,834	:	DECISION REFUSING STATUS
Filed: April 25, 2001	:	UNDER 37 CFR 1.47(a)
Attorney Docket No. 2000-0255	:	

This is in response to the petition pursuant to 37 CFR 1.47(a), filed February 12, 2002.

The petition under 37 C.F.R. 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. 1.136(a).

The above-identified application was filed on April 25, 2001, without an executed oath or declaration. Accordingly, on June 18, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration. To make timely this reply, applicant obtained a five month extension of time and included a Certificate of Mailing dated January 18, 2002. Applicant included a declaration signed by inventors Raymond Ng and Divesh Srivastava. The declaration lacked a signature from inventor Olga Kapitskaia.

On petition, attorney Benjamin Lee included a declaration of facts from Felicia Adadevoh, the person having firsthand knowledge of the efforts taken to transmit the application papers to Kapitskaia. According to Adadevoh, the oath and declaration "along with other papers" were forwarded to Kapitskaia via Federal Express in late August, 2001. In addition, Adadevoh states that no response as of the date of the petition has been received, and the Federal Express package was not returned to sender.

A grantable petition under 37 C.F.R. 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having

been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 C.F.R. 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Rule 47 applicant has not met requirement (1) above.

As to requirement (1), applicant has not demonstrated that a copy of the entire application papers (specification, including claims and drawings) were sent for the nonsigning inventor's review. The record only establishes that a copy of the declaration was forwarded for signature. Requiring that an inventor be presented with the application papers before a petition under 37 C.F.R. 1.47 is granted "ensures that the inventor is apprised of the application to which the oath or declaration is directed."¹

Furthermore, the petition reveals that on January 18, 2002, Kapitskaia stated she would try to sign and return the declaration within a week's time. Accordingly, on renewed petition, Rule 47 applicant must either provide a copy of the executed declaration, or applicant must state that the declaration was never received.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

Christina Lauter Donnell for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ MPEP 409.03(d).